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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/583,312   | 04/26/2007  | Ralf Dunkel          | 2400.0560000/SRL    | 3233             |
| 26111 7590 12/31/2008<br>STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.<br>1100 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      |                     |                  |
| EXAMINER<br>FIERRO, ALICIA LORETTA   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 4121   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 12/31/2008   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/583,312

**Applicant(s)**

DUNKEL ET AL.

**Examiner**

ALICIA L. FIERRO

**Art Unit**

4121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/86)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Claims 1-8 are pending in the instant application, filed on June 15, 2006. This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/EP2004/013834, filed December 6, 2004.

### ***Election/Restrictions***

As written, claim 5 contains non-statutory subject matter.

Refer to 35 U.S.C. 101:

*Inventions Patentable: Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

For the purposes of restriction, the Examiner will interpret claim 5 as a method of using the instantly claimed compounds of structure (I).

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I      Claim(s) 1-2 and 4, drawn to a product of structure (I) and a composition of said product, wherein M stands for M-1 and A is the structure (A1) or (A3).

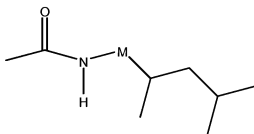
- Group II      Claim(s) 1-2 and 4, drawn to a product of structure (I) and a composition of said product, wherein M stands for M-1 and A is the structure (A2).
- Group III     Claim(s) 1-2 and 4, drawn to a product of structure (I) and a composition of said product, wherein M stands for M-2, M-3, or M-4 and A is the structure (A1) or (A3).
- Group IV      Claim(s) 1-2 and 4, drawn to a product of structure (I) and a composition of said product, wherein M stands for M-2, M-3, or M-4 and A is the structure (A2).
- Group V       Claim(s) 3 and 7, drawn to a method of preparing a compound of structure (I) and a composition of said compound, wherein M stands for M-1 and A is the structure (A1) or (A3).
- Group VI      Claim(s) 3 and 7, drawn to a method of preparing a compound of structure (I) and a composition of said compound, wherein M stands for M-1 and A is the structure (A2).
- Group VII     Claim(s) 3 and 7, drawn to a method of preparing a compound of structure (I) and a composition of said compound, wherein M stands for M-2, M-3, or M-4 and A is the structure (A1) or (A3).
- Group VIII    Claim(s) 3 and 7, drawn to a method of preparing a compound of structure (I) and a composition of said compound, wherein M stands for M-2, M-3, or M-4 and A is the structure (A2).
- Group IX      Claim(s) 5 and 6, drawn to a method of using a compound of structure (I), wherein M stands for M-1 and A is the structure (A1) or (A3).

- Group X      Claim(s) 5 and 6, drawn to a method of using a compound of structure (I), wherein M stands for M-1 and A is the structure (A2).
- Group XI     Claim(s) 5 and 6, drawn to a method of using a compound of structure (I), wherein M stands for M-2, M-3 or M-4 and A is the structure (A1) or (A3).
- Group XII    Claim(s) 5 and 6, drawn to a method of using a compound of structure (I), wherein M stands for M-2, M-3 or M-4 and A is the structure (A2).
- Group XIII   Claim(s) 8, drawn to a product of structure (III), wherein M stands for M-1.
- Group XIV    Claim(s) 8, drawn to a product of structure (III), wherein M stands for M-2, M-3 or M-4.

2. As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions." Moreover, as stated in Rule 13.2 PCT, Unity of Invention is satisfied "where a group of inventions is claimed in one and the same international application, the requirement of unity referred to in Rule 13.1 shall be fulfilled only where there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features."

3. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art so linked as to form a single general inventive concept. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the claims is a compound of formula (I). Prior art exists which causes the core structure in the instant application to lack a special



technical feature. The core structure here is:

this structure, M could be M-1, M-2, M-3, or M-4 according to the definitions given in claim1. This structure can be found in numerous patents and papers. For example, the compound of formula (I) shown in the abstract of DE 102 29 595 A1 (provided by Applicant) utilizes this core structure, wherein M is a phenyl group (M-1). Therefore, the feature linking the claims does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art.

Accordingly, Groups I-XIV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept. Therefore, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

#### ***Election of Species***

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

5. As an additional requirement, with the election of any one of **Groups I-XIV**, an election of species of a particular compound is also required. In order for this election to be considered fully responsive to this requirement, the election **must include**:

**Groups I-XII:**

- a) the **name** and **structure** of one species of the instantly claimed compound of formula (I).
- b) the **location** of the species (a) within the claims or (b) within the specification,
- c) the **claims** that read on the elected species,
- d) a **definition** of the exact substitutions,  
e.g. R<sub>1</sub> is hydrogen, X is oxygen, etc...

**Groups V-VIII:**

- a) the **name** and **structure** of one species of the instantly claimed compound of formula (II), (III), (IV), and (V).
- b) the **location** of the species (a) within the claims or (b) within the specification,
- c) the **claims** that read on the elected species,
- d) a **definition** of the exact substitutions,  
e.g. R<sub>1</sub> is hydrogen, X is oxygen, etc...

**Groups XIII-XIV:**

- a) the **name** and **structure** of one species of the instantly claimed compound of formula (III).

- b) the **location** of the species (a) within the claims or (b) within the specification,
- c) the **claims** that read on the elected species,
- d) a **definition** of the exact substitutions,  
e.g. R<sub>1</sub> is hydrogen, X is oxygen, etc...

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. The claims are deemed to correspond to the species listed above in the following manner: Claim 2 corresponds to various structurally different compounds of formula I. The following claim(s) are generic: claims 1 and 4 are generic to Groups I-IV; claims 3 and 7 are generic to Groups V-VII; claims 5 and 6 are generic to Groups IX-XII; And claim 8 is generic to Groups XIII-XIV.



7. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the core structure of the generic compound fails to overcome that of the prior art, namely DE 102 29 595 A1, for reasons discussed in the restriction requirement above. Additionally, for example, a compound of Formula I wherein A is A1 is structurally different than a compound of formula I wherein A is A2. Therefore, these two compounds are different species or lack the same core structure or special technical feature.

8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALICIA L. FIERRO whose telephone number is

(571)270-7683. The examiner can normally be reached on Monday - Friday 7:30-5:00 with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.L.F.

/Patrick J. Nolan/

Supervisory Patent Examiner, Art Unit 4121